

Remarks

This is responsive to the Office Action mailed May 31, 2007. The amendments do not contain new matter and without prejudice serve to cancel a claim and to more particularly point out and distinctly claim that which is patentable to place the claims in better form for allowance or appeal.

Support for the amendments to claims 1, 9, and 16 to more particularly recite that the access instructions are associated with a predefined number of playings is found at least in the specification at page 5 lines 28-31.

Support for the amendment to claim 9 to more particularly recite a "pocket enclosure" is found at least in the specification at page 3 lines 19-25, and ordinarily means the enclosure is sized to "fit in a pocket," analogous to the meaning of "pocket knife" being limited to a knife that fits in a pocket.

Claim 33 is canceled without prejudice solely in an effort by Applicant to reduce the number of outstanding issues for allowance or appeal.

Rejection Under 35 U.S.C. 103(a)

Claims 1-5, 8, 16-21, and 23-32 stand rejected as being unpatentable over Chung '963 in view of Downs '618.

Applicant has amended claims 1 and 16 to more particularly recite the access instructions being associated with *a predefined number of authorized playings of the entertainment media*.

The following statement by the Office is misplaced:

Downs specifically discloses wherein the portable device will have computer software, i.e. a "User Player

Application” stored thereon for controlling access to the entertainment media (column 7, lines 11-22 and column 11, lines 30-55)¹

Actually, the Office’s characterization is a misnomer because the software to which it refers is what Downs ‘618 refers to as the “End-User Player Application.” This distinction in name is important because Downs ‘618 clearly discloses that the End-User Player Application 195 resides in the End-User Device 109, not the portable device.² Downs ‘618 discloses the End-User Device 109 as being a non-portable device, such as a personal computer, a set-top box, or an internet appliance.³ Downs ‘618 further discloses that the End-User Device 109 can be used to copy the Digital Content to a portable device.⁴

Although Downs ‘618 discloses that the portable device can “perform a subset of the End-User Player Application 195 functions,”⁵ Downs ‘618 does not teach or suggest storing the End-User Player Application 195 in the portable device, or in any way running the End-User Player Application 195 independently of the End-User Device 109. Rather, Downs ‘618 explicitly states that the End-User Player Application 195 always resides in and runs on the End-User Device 109.⁶

The cited references cannot sustain obviousness at least because they do not teach or suggest *encoding the portable digital storage module with access instructions corresponding to a predefined number of authorized playings of the entertainment media* as recited by claim 1, and they do not teach or suggest *store access instructions associated with a predefined number of authorized playings of the user-selected entertainment media* as recited by claim

¹ Office Action of 5/31/2007 pg. 2 lines 8-11 (emphasis added)

² see, for example, Downs ‘618 col. 7 lines 41-43.

³ Downs ‘618 col. 6 lines 43-45; col. 11 lines 33-34.

⁴ Downs ‘618 col. 6 lines 43-45; col. 11 lines 47-48.

⁵ Downs ‘618 col. 11 lines 49-50.

⁶ Downs ‘618 col. 11 lines 52-54: “The terms End-User(s) and End-User Player Application 195 are used throughout this to mean through the use or running-on an End-User Device(s) 109.”

16. Accordingly, Applicant respectfully requests reconsideration of the rejection of claims 1 and 16 and the claims depending therefrom in view of the clarifying amendments to claims 1 and 16.

Rejection Under 35 U.S.C. 103(a)

Claims 9, 10, and 15 stand rejected as being unpatentable over Chung '963 in view of Yamagata '793 and further in view of Downs '618.

For the same reasons set forth above, Applicant has amended claim 9 to more particularly claim *a controller...granting the digital format player device access to data stored in the memory according to a predefined number of authorized playings*. Neither Chung '963 nor Yamagata '793 cure the deficiency of Downs '618 in this regard.

Furthermore, Applicant has stated its agreement in the record that neither Chung '963 nor Downs '618 teaches the claimed *controller*. Although Applicant reiterates that Yamagata '793 is improper nonanalogous art, it has nonetheless further amended claim 9 to more particularly recite a "pocket enclosure" containing the controller. Yamagata '793 does not teach or suggest this size feature because neither its 3.5 inch nor its 5.5 inch drive is sized to fit in a pocket.⁷

Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 9 and the claims depending therefrom in view of the clarifying amendments to claim 9.

Conclusion

This is a complete response to the Office Action mailed May 31, 2007. Applicant requests withdrawal of all rejections and passage of all the pending claims to allowance.

Also submitted herewith is a request for telephone interview. Absent allowance, Applicant respectfully requests the opportunity for a telephone interview to clarify unresolved issues preventing this case from passing to allowance.

The Office is invited to contact the undersigned should any questions arise concerning this response or any other matter in this case.

Respectfully submitted,

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⁷ see Yamagata '793 col. 2 lines 28-45; 3.5 inch disk drive is 41.3mm x 102mm x 146mm, and 5.5 inch disk drive is 82.5mm x 140 mm x 207mm.